

Appl. No. 10/632,375
Atty. Docket No. AA540C
Amtd. dated October 27, 2004
Reply to Office Action of April 27, 2004
Customer No. 27752

REMARKS

Claims 1-20 are pending in the present application. Claim 1 has been amended to further define the present invention wherein the matter of Claim 2 has been incorporated into the claims and a further defining of the phase changing agent. Claim 2 has been canceled. Claim 3 has been amended to be dependent on Claim 1 rather than Claim 2, now canceled.

In particular, Claim 1 has been further defined wherein wherein the heat generating agent is an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof and wherein the polyoxyalkylene derivative is a polyoxyethylene/polyoxypropylene block copolymer. Support for this amendment is found in Claim 2, as originally filed, and now canceled.

Claim 1 has further been defined wherein the phase changing agent has a melting point of from about 30°C to about 60°C. Support for this amendment is found on page 5 of the specification at lines 34-36.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

REJECTIONS

1) & 2) Double Patenting Rejection

Claims 1-20 have been provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over Claims 1-15 and 18 of copending Application No. 10/273,816 as well as over Claims 1-23 of copending Application No. 10/632,279. In setting forth this rejection, the Examiner indicated that a timely filed Terminal Disclaimer over these common owned applications would overcome the rejection.

Responsive to this rejection, a Terminal Disclosure under 37 C.F.R. 1.321(c) for the above-entitled application which specifies that the Petitioner disclaims the terminal part of the statutory term of any patent granted on the above entitled application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to §156 and §173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending Application Numbers 10/273,816 and 10/632,279. Submission of the Terminal Disclaimer thus obviates the provisional obviousness-type double patenting.

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3) 35 U.S.C. § 102(b) as being anticipated by EP 897719 (EP 719)

Claims 1, 4, 6-7 and 12-14 are rejected under 35 U.S.C. § 102(b) as being anticipated by EP 897719 (EP 719). Applicants respectfully traverse this rejection.

EP 719 discloses topical compositions comprising a solid heat generating material that generates heat upon mixing with water, an anionic surfactant and an anhydrous carrier or diluent. EP 719 discloses the use of inorganic particles such as zeolite as a heat generating material. However, EP 719 does not disclose or teach the specific inorganic salts of the present invention, as found in original Claim 2, and now incorporated into Claim 1 of the present invention. Namely, EP 719 does not teach an inorganic heat generating agent as an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof.

Therefore, the present invention is not anticipated by EP 719 and Applicants request reconsideration and withdraw of the rejection.

4) 35 U.S.C. § 102(e) as being anticipated by US 2002/0051798 to Koike et al ('798)

Claims 1-4, 6, 7, 9 and 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by US 2002/0051798 to Koike et al ('798). Applicants respectfully traverse this rejection.

'798 discloses a gommage cosmetic composition comprising a water soluble polymer and a substance that is liquid at 25°C (excluding water). Further '798 discloses that the cosmetic composition may comprise a component which generates heat upon contact with water for the purpose of giving users a warmed feeling in addition to the effect of the gommage. Examples of such a component include various inorganic salts such as magnesium sulfate, calcium chloride and magnesium chloride.

However, '798 does not disclose or teach a phase changing agent having a melting point of from about 30°C to about 60°C, as now incorporated into Claim 1 of the present invention. '798 teaches the use of behenyl alcohol, a fatty alcohol which is conventionally known to one of skill in the art to have a melting point of about 63°C to 73°C. Therefore, there is no disclosure in '798 of a phase changing agent having a melting point of from about 30°C to about 60°C, as now required by the present invention.

Therefore, the present invention is not anticipated by '798 and Applicants request reconsideration and withdraw of the rejection.

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5) 35 U.S.C. § 102(e) as being anticipated by US application 10/273,816 (PGPUB no. 2003/01082502)

Claims 1-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by US application 10/273,816 (2003/01082502). Applicants respectfully traverse this rejection.

The Examiner has asserted that the applied reference has common inventors with the instant application. Based upon the earlier effective filing date of the reference, the Examiner has asserted that US application 10/273,816 constitutes prior art under 35 U.S.C. § 102(e).

Applicants respectfully direct the Examiner's attention to the effective filing dates and claimed priorities of the instant application and the applied reference. The instant application is a continuation application and properly claims priority to the parent application PCT/US01/03425 filed 02/01/2001. However, the applied reference, US application 10/273,816 has an effective filing date of 10/30/2001, which is later than the effective filing date of the instant application. Therefore, Applicants do not believe that the 102(e) rejection is proper and request reconsideration and withdraw of this rejection.

Further, the Examiner has asserted that Claims 1-20 of the instant application are directed to the same invention as that of Claims 1-18 of commonly assigned 10/273,816. The Examiner has further asserted that the issue of priority under 35 U.S.C 102(g) and possibly 102(f) of this single invention should be resolved. Applicants would like to point out that the claims of the present application have been amended to further define the instant invention and are not directed to the same invention as that of Claims 1-18 of commonly assigned 10/273,816. In particular, the instant invention, as now amended, requires the inorganic heat generating agent is an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof. This is not a required element of the co-pending application claims. Further, the instant invention, as now amended, requires a phase changing agent having a melting point of from about 30°C to about 60°C and are dispersed in the inert carrier. This is not a required element of the co-pending application claims. Therefore, in view of the instant invention, as now amended, Claims 1-20 of the instant invention are not directed toward the same invention as Claims 1-18 of commonly assigned 10/273,816 (PGPUB No. 2004/0028711). As discussed above, the instant application is a continuation application and properly claims priority to the parent application PCT/US01/03425 filed 02/01/2001. The applied reference, US application 10/273,816 has an effective filing date of 10/30/2001.

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6) The Examiner has asserted that Claims 1-20 are directed toward the same invention as that of Claims 1-23 of commonly owned 10/632,279 (PGPUB No. 2004/0022823). The Examiner has further asserted that the issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved. Applicants would like to point out that the claims of the instant application have been amended to further define the instant invention and are not directed to the same invention as that of Claims 1-23 of commonly assigned 10/632,279. In particular, the instant invention, as now amended, requires a phase changing agent having a melting point of from about 30°C to about 60°C and are dispersed in the inert carrier. This is not a required element of the co-pending application claims. This is not a required element of the co-pending application claims. Therefore, in view of the instant invention, as now amended, Claims 1-20 of the instant invention are not directed toward the same invention as Claims 1-23 of commonly owned 10/632,279 (PGPUB No. 2004/0022823).

7) The Examiner has asserted that commonly assigned 10/273,816 and 10/632,279 would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application were made. In order for the Examiner to resolve this matter, the Assignee is required under 35 U.S.C. 103(c) and 37 C.F.R. 178(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter.

Applicants respectfully submit that commonly assigned 10/273,816 and 10/632,279 were commonly owned at the time the invention in this application was made. Applicants provide the recordation of assignments for each of the applications as follows:

Appln. 10/632,279 - Date Recorded 1-23-04 at Reel No. 014281 Frame No. 0902; Appln. 10,273,816 - Date Recorded 12/20/02 at Reel No. 013313 Frame No. 0013; Appln. 10,632,375 - Date Recorded 8/13/04 at Reel No. 015061 Frame No. 0920.

103 Rejections

8) Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koike et al ('798). Applicants respectfully traverse this rejection.

In order to establish a prima facie case of obviousness, the Examiner must show that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

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reference teachings, (2) there is a reasonable expectation of success, and (3) all of the limitations of the claims are taught or suggested in the prior art (M.P.E.P. § 2143).

However, all of the limitation of the claims are not taught or suggested in the prior art. Specifically, as the Examiner asserts, '798 discussed in the above paragraphs, fails to teach the specific alcohols with polyethylene glycol as an inert carrier. The Examiner asserts, however, that '798 does teach a combination of behenyl alcohol and polyethylene glycol (tables 3 and 4), and therefore '798 teaches a composition for the same purposes as that of the instant invention. Therefore, the Examiner has asserted that it would have been obvious for one of skill in the art at the time of the instant invention, to use a suitable fatty alcohol such as behenyl alcohol such that the heat generating and cleansing effect of the composition is not compromised.

However, as Applicants has stated above, '798 does not disclose or teach a phase changing agent having a melting point of from about 30°C to about 60°C, as now incorporated into Claim 1 of the present invention. '798 teaches the use of behenyl alcohol, a fatty alcohol which is conventionally known to one of skill in the art to have a melting point of about 63 °C to 73°C. Therefore, there is no disclosure in '798 of a phase changing agent having a melting point of from about 30°C to about 60°C, as now required by the present invention. Therefore, all of the limitations of the claims, as now amended, are not taught or suggested '798. Applicants have shown that there is therefore no *prima facie* cast of obviousness and respectfully request withdraw of the rejection.

Further, in '798, the only disclosure of behenyl alcohol, a fatty alcohol, is found in Tables 3 and 4, which disclose compositions comprising activated zeolites, behenyl alcohol and polyethylene glycol. Conventionally, the amount of heat generation of activated zeolites is lower than that of the inorganic salts, as required in the present invention. Thus, the compositions of '798 do not warm up to the desired temperature of the present invention and/or do not affect consumer acceptance even if the compositions warm up to a higher temperature than expected. There is no motivation in '798 to need to seek a control of the temperatures in such compositions. The Examiner has asserted that '798 teaches compositions for the same purpose as that of the instant invention i.e. generating heat upon contact with water comprising the ingredients such as inorganic heat generating means, polyethylene glycol, etc., which primarily to the heat generating effect. However, in the present invention, the phase changing agent having a certain melting point, as now claimed, can absorb a heat from the anhydrous inorganic salt by changing its phase from solid to liquid, and then, release the heat slowly by changing its phase from liquid to solid. Thus, the phase changing agent can prevent the compositions from warming up to a higher temperature than expected, and provide prolonged warming from the compositions, without using

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coated heat generating agents (page 3, lines 7-13). Therefore, Applicants have demonstrated that the compositions of the present invention are not for the same purpose as that of '798. And one of skill in the art would not be motivated by the teachings of '798 and the mere recitation of behenyl alcohol in combination with activated zeolites and polyethylene glycol, to arrive at the instant invention. Further, behenyl alcohol is a fatty alcohol outside of the now claimed melting point for the phase changing agent and there would be no motivation to one of skill in the art from the mere recitation of behenyl alcohol to look to other phase changing agents. Again, '798 does not even recognize the need for phase changing agents, as found in the present invention.

Therefore, '798 does not meet either the criteria that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and all of the limitations of the claims, as now amended, are not taught or suggested '798. Applicants have shown that there is therefore no *prima facie* cast of obviousness and respectfully request withdraw of the rejection.

9) Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over '798 by itself or in view of US 6,540,989 to Janchitraponvej ('989). Applicants respectfully traverse this rejection.

The Examiner asserts that '798 fails to teach the composition for hair conditioning and lacks amidoamines of the instant claims. '989 teaches a self-warming hair composition comprising a glycol, a quaternary ammonium compound, an amidoamine and a silicone. The Examiner asserts that it would have been obvious for one of skill in the art at the time of the invention to add amido amine of '989 to the composition of '798 . Applicants respectfully traverse this rejection.

All of the limitation of the claims are not taught or suggested in the prior art. Specifically, as the Examiner asserts, '798 discussed in the above paragraphs, fails to teach the specific alcohols with polyethylene glycol as an inert carrier. The Examiner asserts, however, that '798 does teach a combination of behenyl alcohol and polyethylene glycol (tables 3 and 4), and therefore '798 teaches a composition for the same purposes as that of the instant invention. Therefore, the Examiner has asserted that it would have been obvious for one of skill in the art at the time of the instant invention, to use a suitable fatty alcohol such as behenyl alcohol such that the heat generating and cleansing effect of the composition is not compromised.

However, as Applicants has stated above, '798 does not disclose or teach a phase changing agent having a melting point of from about 30°C to about 60°C, as now incorporated

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into Claim 1 of the present invention. '798 teaches the use of behenyl alcohol, a fatty alcohol which is conventionally known to one of skill in the art to have a melting point of about 63 °C to 73°C. Therefore, there is no disclosure in '798 of a phase changing agent having a melting point of from about 30°C to about 60°C, as now required by the present invention. Therefore, all of the limitations of the claims, as now amended, are not taught or suggested '798. Likewise, '989 neither teaches a phase changing agent having a melting point of from about 30°C to about 60°C, as now required by the present invention, nor does '989 teach the use of inorganic salt heat generating agents, as now required by the present invention in Claim 1 and from which Claims 15-20 depend. Applicants have shown that there is therefore no *prima facie* cast of obviousness and respectfully request withdraw of the rejection.

10) Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over '798 by itself or in view of EP 027 730 (EP '730). Applicants respectfully traverse this rejecction.

The Examiner asserts that Claims 9-11 recite polyoxyalkylene derivatives; in particular Claims 8 recites polyoxyethylene/polyoxypropylene block copolymer. The Examiner asserts that '798 fails to specifically teach the claimed polyoxyalkylene derivatives of the instant claims. EP '730 teaches cosmetic compositions for hair or skin treatment, comprising heat generating compounds when brought into contact with water. Among the heat generating compounds EP '730 teaches fatty alcohols, alkylene glycols and polyoxyalkylene derivatives. Therefore, the Examiner asserts that it would have been obvious for one of skill in the art to use pluronic or any other suitable polyoxyalkylene derivatives as heat generating agents in the composition of '798 because EP '730 teaches that the above polyoxyalkylene derivatives are preferable as heat generating compounds and suggest that the heat generating compound give an excellent finishing and cleansing effect to consumer upon application, which results in a comfortable hot feeling. However, the Examiner has not provided the requisite motivation to combine or modify '798 with '730 so as to obtain Applicants invention. The present invention, as now amended, requires the use of an inorganic heat generating agent as an anhydrous inorganic salt selected from the group consisting of sodium sulfate, calcium sulfate, magnesium sulfate, aluminum sulfate, calcium chloride, magnesium chloride, calcium oxide, and mixtures thereof. In the present invention, it is believed that polyalkylene derivatives can help the dispersion of inorganic heat generating agents and thus prevent the agglomeration of inorganic heat generating agents which causes gritty feel to the skin and/ or hair.

However, all of the limitation of the claims are not taught or suggested in the prior art. Specifically, as the Examiner asserts, '798 discussed in the above paragraphs, fails to teach the specific alcohols with polyethylene glycol as an inert carrier. The Examiner asserts, however, that

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'798 does teach a combination of behenyl alcohol and polyethylene glycol (tables 3 and 4), and therefore '798 teaches a composition for the same purposes as that of the instant invention. Therefore, the Examiner has asserted that it would have been obvious for one of skill in the art at the time of the instant invention, to use a suitable fatty alcohol such as behenyl alcohol such that the heat generating and cleansing effect of the composition is not compromised.

However, as Applicants has stated above, '798 does not disclose or teach a phase changing agent having a melting point of from about 30°C to about 60°C, as now incorporated into Claim 1 of the present invention. '798 teaches the use of behenyl alcohol, a fatty alcohol which is conventionally known to one of skill in the art to have a melting point of about 63 °C to 73°C. Therefore, there is no disclosure in '798 of a phase changing agent having a melting point of from about 30°C to about 60°C, as now required by the present invention. Therefore, all of the limitations of the claims, as now amended, are not taught or suggested '798. Likewise, '730 neither teaches a phase changing agent having a melting point of from about 30°C to about 60°C, as now required by the present invention, nor does '730 teach the use of inorganic salt heat generating agents, as now required by the present invention in Claim 1 and from which Claims 9-11 depend. Therefore, all of the limitation of the claims are not taught or suggested in the prior art. Applicants have shown that there is therefore no *prima facie* cast of obviousness and respectfully request withdraw of the rejection.

Further, neither '798 or '730 recognize the problem the need of the present invention. The present invention comprises a phase changing agent having a certain melting point, as now claimed, which can absorb a heat from the anhydrous inorganic salt by changing its phase from solid to liquid, and then, release the heat slowly by changing its phase from liquid to solid. Thus, the phase changing agent can prevent the compositions from warming up to a higher temperature than expected, and provide prolonged warming from the compositions, without using coated heat generating agents (page 3, lines 7-13). Therefore, Applicants have demonstrated that the compositions of the present invention are not for the same purpose as that of '798 and '730. And one of skill in the art would not be motivated by the teachings of '798 and '730 to arrive at the instant invention. Further, behenyl alcohol is a fatty alcohol outside of the now claimed melting point for the phase changing agent and there would be no motivation to one of skill in the art from the mere recitation of behenyl alcohol to look to other phase changing agents. Again, '798 does not even recognize the need for phase changing agents, as found in the present invention.

Therefore, '798 and '730 do not meet either the criteria that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and all of the

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limitations of the claims, as now amended, are not taught or suggested '798 or '730. Applicants have shown that there is therefore no prima facie cast of obviousness and respectfully request withdraw of the rejection.

'798 teaches the use of components such as magnesium chloride, calcium chloride and magnesium sulfate as a component that generates heat upon contact. However, there is no teaching in '798 recognizing the benefit of using a phase generating agent. Therefore, one of skill in the art would not be motivated to combine '798 with another reference, in order to provide a solution to this problem. '730 teaches that polyoxyalkylene derivatives act as heat generating compounds. There is no teaching in '730 that phase changing agent having a certain melting point, as now claimed in the present invention, which can absorb a heat from the anhydrous inorganic salt by changing its phase from solid to liquid, and then, release the heat slowly by changing its phase from liquid to solid. And no teaching in '730 that a phase changing agent can prevent the compositions from warming up to a higher temperature than expected, and provide prolonged warming from the compositions. And even if '730 was combined with '798, there is no motivation to select the a phase changing agent at the specified melting points of the present invention, as now amended. Applicants have shown that there is therefore no prima facie cast of obviousness and respectfully request withdraw of the rejection.

Conclusion

Applicants have made an earnest effort to place their application in proper form and distinguish their claimed invention from the prior art which was applied in the April 27, 2004 Office Action. WHEREFORE, consideration of this application, consideration of the accompanying claims and claim amendments submitted herewith, withdrawal of the rejections under 35 U.S.C § 102 and 35 U.S.C § 103, and allowance of Claims 1-20 are respectfully requested.

Respectfully submitted,

Mikio Uchida et al.

By Linda M. Sivik

Linda M. Sivik
 Agent for Applicants
 Registration No. 44,982
 Tel. No. (513) 626-4122

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